

REMARKS

In the Office Action¹ mailed October 14, 2009, the Examiner rejected claims 1-23 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In addition, claims 1-12, 17, 19, 22-35, 40, 42, 45-58, 63, 65, 68-81, 86, 88, 91, and 92 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,774,554 ("*Gilham*") in view of U.S. Patent No. 6,385,504 ("*Pintsov*"). Claims 13-16, 18, 20, 21, 36-39, 41, 43, 44, 59-62, 64, 66, 67, 82-85, 87, 89, and 90 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gilham* in view of *Pintsov*, and further in view of Official Notice.

By this response, Applicant has amended claims 1, 24, 47, and 70. No new matter has been added as the amendments are supported at paragraph 54 of the specification among other places. Claims 1-92 remain pending and under examination.

Rejection of Claims 1-23 under 35 U.S.C. § 101

Applicant thanks the Examiner for providing a suggestion for overcoming the statutory subject matter rejection of claims 1-23. In response, Applicant has amended independent claim 1 to recite "a method, implemented on a computer system," and "comparing, using the computer system, the verification data obtained from the delivery payment coding to a verification database." Applicant understands from the Examiner's remarks that this is sufficient to recite statutory subject matter and Applicant respectfully requests the Examiner to withdraw the § 101 rejection of claims 1-23.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Rejection of Claims 1-92 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 1-92 under 35 U.S.C. § 103(a) as being unpatentable over *Gilham* in view of *Pintsov* or over *Gilham* in view of *Pintsov*, and further in view of Official Notice, because a *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. ... [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). "The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01(III) (emphasis in original). "All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03. "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences *themselves* would have been obvious, but whether the claimed invention as a *whole* would have been obvious." M.P.E.P. § 2141.02(I) (emphases in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). ... The factual inquiries ... [include determining the scope and content of the prior art and] ... [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s)

between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

A *prima facie* case of obviousness has not been established at least because the cited references and Official Notice fail to teach or suggest all the elements of independent claim 1, as amended. Amended claim 1 recites, among other things, "wherein, if the verification data obtained from the delivery payment coding matches corresponding verification data in the verification database, the method further comprises: updating the verification database with a time or a location of the item in the item delivery system; and using the electronic notification information to electronically transmit to the sender a notice containing the time or the location of the item in the item delivery system." As the Office Action correctly recognizes, *Gilham* does not teach or suggest anything related to "updating the verification database indicating that the item is in route through the item delivery system to a recipient." Office Action p. 15. Similarly, *Gilham* does not teach or suggest at least the above-recited elements that have been added to claim 1.

Pintsov similarly fails to teach or suggest the above-recited elements of amended claim 1, among others. More specifically, independent claim 1, as amended, recites "updating the verification database with a time or a location of the item in the item delivery system; and using the electronic notification information to electronically transmit to the sender a notice containing the time or the location of the item in the item delivery system." (Emphasis added). *Pintsov* does not teach electronically transmitting a notice to the sender containing the time or location of the item in the item delivery system because *Pintsov* only teaches that an "identifier can serve as a basis for track

and trace capability and for providing special services such as certified, insured or registered mail." *Pintsov* col. 6:67 - 7:2. The track and trace services of *Pintsov* are not the same as electronically transmitting a notice to the sender containing the time or location of the time in the item delivery system because track and trace services like *Pintsov's* at the time of the invention were only capable of sending a paper notice back to the sender when an item was delivered, or updating a record in an on-line accessible database and requiring a sender to log into a website to check the tracking information. A conventional system, such as *Pintsov's*, could not "electronically transmit to the sender a notice containing the time or the location of the item in the item delivery system" because *Pintsov's* system does not collect electronic notification information, such as a phone number, an email address, an IP address, etc., from the sender. For at least these reasons, *Pintsov* fails to disclose "using the electronic notification information to electronically transmit to the sender a notice containing the time or the location of the item in the item delivery system" as recited by amended claim 1.

The Official Notice taken in the Office Action fails to cure the defects of *Pintsov* and *Gilham*. The Official Notice notes that conventional systems at the time of the invention, such as "UPS and FedEx have [information indicating that the item is in route through the item delivery system] on their website where a user can check the status of the mailed item." Office Action p. 15. For the reasons explained with regard to *Pintsov*, this is not the same as "using the electronic notification information to electronically transmit to the sender a notice containing the time or the location of the item in the item delivery system" as recited by amended claim 1 because this requires that a user log into the website to check the status of the mailed item. Logging into a website is very

different from having a notice transmitted because logging in requires the sender to actively seek out the information.

For at least the foregoing reasons, the cited references fail to teach or suggest all the elements of independent claim 1, as amended. In addition, there are significant differences and gaps between the teachings of the cited references and the invention of claim 1, as a whole, that are so great as to render claim 1 nonobvious to one reasonably skilled in the art. M.P.E.P. § 2141. Thus, no reason has been clearly articulated as to why amended claim 1 would have been obvious to one of ordinary skill in the art in view of the cited prior art. Accordingly, the Office Action does not establish a *prima facie* case of obviousness with respect to amended independent claim 1, claim 1 is allowable over the cited references, and the Applicant respectfully requests that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Amended independent claims 24, 47 and 70, although different in scope, contain similar recitations as those of amended claim 1. For at least the reasons discussed with regard to claim 1, the Office Action does not establish a *prima facie* case of obviousness with respect to amended independent claims 24, 47 and 70, these independent claims are allowable, and Applicant respectfully requests the Examiner withdraw the section 103 rejections of these claims.

Furthermore, because a *prima facie* case of obviousness has not been made for independent claims 1, 24, 47 and 70, a *prima facie* case of obviousness has also not been established for claims 2-23, 25-46, 48-69, and 71-92, by virtue of their dependence on the independent claims. Thus, dependent claims 2-23, 25-46, 48-69, and 71-92 are allowable by virtue of their dependence from allowable independent

claims, as well as by reason of reciting additional features not taught or suggested by the cited references. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of claims 1-92 under 35 U.S.C. § 103(a) and speedily issue a notice of allowance for the pending claims.

Conclusion

If the Examiner believes that a conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (571) 203-2430.

Please grant any extensions of time required to enter this Response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

DRAFT

Dated: January 14, 2010

By: /Melanie Grover/
Melanie Grover
Reg. No. 63,599